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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,722	08/14/2001	James M. Zavislan	ML-0473C	1148

7590 02/28/2002  
Kenneth J. LuKacher, Esq.  
South Winton Court  
Suite 204  
3136 Winton Road South  
Rochester, NY 14623

EXAMINER
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MAXIE, CHRISTOPHER S

ART UNIT	PAPER NUMBER
2872	

DATE MAILED: 02/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/929,722

Applicant(s)

ZAVISLAN, JAMES M.

Examiner

Christopher S. Maxie

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2001.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities:

pg. 1 line 1 the word "be" should be changed to "by"

pg. 2; second paragraph the word "illuminate" should be changed to "illuminates"

pg. 6 TEM<sub>02</sub> modes are not spaced pairs equal and opposite in amplitude

Fig. 2 number 44 is not disclosed in the specification

Fig. 3 pg. 6 lines 26-27 disclose a "...polarizing or leaky beam splitter 60..."

elsewhere in the specification numeral 60 refers to a non-polarizing beam splitter.

Appropriate correction is required.

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: the continuation data for the claimed benefit of domestic priority does not appear in declaration.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

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and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 12, 14, and 18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 6, 10, 11, and 12 of U.S. Patent No. 6,304,373; claims 1, 3, 4, 7, 8, 9, 10, 20, 21, and 27 of U.S. Patent No. 6,134,009; and claims 1, 2, 3, 8, 9, 10, 11, and 27 of U.S. Patent No. 6,134,010. Although the conflicting claims are not identical, they are not patentably distinct from each other because,

Zavislan (6,304,373; 6,134,009; 6,134,010) discloses a scanning confocal microscope comprising: a laser, a beam splitter, a scanner for scanning an image plane in a specimen section generally orthogonal X-Y directions in a focal plane in said section capable of overlapping spots at one of behind, ahead, or behind and ahead of said section, an objective for focusing said spots in said focal plane, a confocal aperture, a photodetector behind said aperture, and optics for focusing light from the spots deflected from beam splitter at said aperture.

Claims 13 and 15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6 of U.S. Patent No. 6,304,373; claims 10, 22, 28 of U.S. Patent No. 6,134,009; and claims 11, 23, 28, of

U.S. Patent 6,134,010. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Zavislan (6,304,373; 6,134,009; 6,134,010) discloses a microscope wherein said objective is movable together in a Z direction generally orthogonal to the X-Y direction.

Claim 16 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 4 of U.S. Patent No. 6,304,373. Although the conflicting claims are not identical, they are not patentably distinct from each other because Zavislan discloses a multimode laser propagating said incident light in TEM modes higher than the TEM<sub>00</sub> mode.

Claim 17 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim claims 25 and 30 of U. S. Patent No. 6,134,009; claims 26 and 30 of U.S. Patent No. 6,134,010. Although the conflicting claims are not identical, they are not patentably distinct from each other because Zavislan discloses a non-polarizing beam splitter. It would have been obvious to one of ordinary skill in the art at the time of the invention that the claims of the references cited above disclose an invention that performs the same function as the invention set forth in the claims of this application.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher S. Maxie whose telephone number is (703) 605-4214. The examiner can normally be reached on M-F 8:00 am. - 4:30 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on (703) 308-1687. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

CSM  
February 25, 2002



Cassandra Spyrou  
Supervisory Patent Examiner  
Technology Center